

Serial No.: 09/811,360

Attorney Docket No. 2502440-991501

Amendment dated December 5, 2003 (resubmitted January 7, 2004)

Reply to Office Action dated September 23, 2003

REMARKS:

Claims 1, 3-25, 27-43 and 50-55 are pending in this application. Claims 1, 8, 10-11, 13-14, 16-18, 20-21, 23-24, 33-34, 36-37, 40-43, 50-51 and 53-54 are currently amended. Claims 56-69 have been cancelled as being drawn to non-elected species. It is respectfully submitted that no new matter has been added.

Claim Rejections Under 35 U.S.C. 103

Claims 1, 3-25, 27-43 and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent no. 4,550,450 to Kinnet, U.S. patent no. 5,571,203 to Masini, U.S. patent no. 4,042,980 to Swanson et al., and German patent no. DE 1164019 to Chiron-Werke. Claims 1, 3-25, 27-43 and 50-55 have been amended and are allowable for the reasons that follow.

COMBINATION DOES NOT PRODUCE INVENTION

The combination of Kinnett and Masini does not produce Applicant's invention as set forth at any of claims 1, 3-25, 27-43 and 50-55, as currently amended. Claim 1, e.g., as currently amended, recites a stemless, ***partial humeral head fixation*** including a partial humeral head including a base surface and a rotationally-stabilizing base extension protruding therefrom including multiple fins for impaction into a cancellous region of the cut humeral surface. The hip replacement teachings of Masini provide a ***stem fixation and not a head fixation.***

To illustrate why this is an important distinction, the Examiner is respectfully referred to the Masini reference, e.g., to Figure 2 of Masini, where an artificial hip is shown including a complete artificial head 446 having a stem or neck 444 protruding

Page 14 of 17

Gray Cary/SF/3096980.1
2502440-991501

Serial No.: 09/811,360

Attorney Docket No. 2502440-991501

Amendment dated December 5, 2003 (resubmitted January 7, 2004)

Reply to Office Action dated September 23, 2003

therefrom. The stem or neck 444 of Masini includes a stem or neck fixation 443, and clearly not a **head** (446) fixation, and certainly not a **partial** head fixation, and definitely not a partial **humeral** head fixation.

Referring now to Kinnett, if the stem or neck fixation 443 of Masini were combined with the apparatus of Figures 1 and 2, then the trapezoidal stem 27b would have a stem fixation protruding from it. This combination would provide a shoulder arthroplasty wherein either of the following would result. In a first case, the trapezoidal stem 27b of the head fixation 10 would protrude out of the cortical region of the cut humerus such that the head fixation 10 would not contact or substantially mate with the cut humeral surface when coupled therewith, as required at Applicant's claim 1, as currently amended. Second, the trapezoidal stem 27b of Kinnett would alternatively be fully impacted into the cancellous region of the cut humerus along with its stem fixation 443 as taught by Masini. In this second case, the elongated trapezoidal stem 27b with stem fixation 443 would impact the medulla and therefore not be non-intramedullary, as required at Applicant's claim 1, as currently amended. As neither case is within the scope of Applicant's invention as set forth at any of claims 1, 3-25, 27-43 and 50-55, as currently amended, then the rejection is overcome and each of these amended claims is now allowable.

NOT OBVIOUS TO COMBINE

It would not have been obvious to one of ordinary skill in the art to combine Masini with Kinnett. The Examiner concedes that his principal reference, Kinnett, does not teach all of the elements of Applicant's invention as set forth in any of the pending claims. The Examiner specifically concedes that Kinnett does not disclose a stabilizing base extension including a plurality of fins. Instead, the Examiner relies upon Masini to teach this feature, and then asserts that it would have been obvious to combine the teachings of Kinnett and Masini. It has already been explained above that Masini does

Serial No.: 09/811,360

Attorney Docket No. 2502440-991501

Amendment dated December 5, 2003 (resubmitted January 7, 2004)

Reply to Office Action dated September 23, 2003

not even teach this feature. In addition, it would not have been obvious to combine Masini and Kinnett, because Kinnett relates to a shoulder prosthesis system and Masini relates to hip replacement. *Masini simply represents non-analogous prior art.* The field of this invention is shoulder arthroplasty and Applicant's claims recite total shoulder arthroplasty apparatuses and methods.

In support of this assertion, Applicant respectfully submits herewith two affidavits. One is from Dr. Eugene M. Wolf, a renowned shoulder arthroplasty specialist and the sole inventor in this application. Dr. Wolf has stated that one would not look in the hip literature for solutions to shoulder arthroplasty issues. The other affidavit is from Dr. Robert S. Ferretti, a renowned hip replacement surgeon. Dr. Ferretti has stated that a shoulder surgeon would not look for solutions to shoulder arthroplasty issues in the hip arthroplasty literature. If the Examiner wishes to oppose the views of these experts in their respective fields that hip replacement literature is not within Applicant's field of endeavor, nor is it reasonably pertinent thereto, then it is submitted that the Examiner must present substantive evidence to the contrary. Otherwise, it is erroneous for the Examiner to maintain that it would have been obvious to combine Kinnett with Masini.

In view of the above, it is respectfully submitted that the application is in condition for allowance. The Examiner is particularly further referred to dependent Claims 15, 22 and 38-39. These claims are dependent from claims 1, 8 and 25 or 31, respectively, and remain in the application although withdrawn from consideration and examination, because they are allowable as being dependent from claims 1, 8 and 25 or 31. The Examiner's reconsideration and further examination are respectfully requested.

Serial No.: 09/811,360

Attorney Docket No. 2502440-991501

Amendment dated December 5, 2003 (resubmitted January 7, 2004)

Reply to Office Action dated September 23, 2003

It is believed that no additional fees are due with the submission of this Amendment. However, the Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

GRAY CARY WARE & FREIDENRICH LLP

Dated: 1-7-04By AVS

Andrew V. Smith
Reg. No. 43,132
Attorney for Applicant

GRAY CARY WARE & FREIDENRICH LLP
153 Townsend Street, Suite 800
San Francisco, CA 94107
Telephone: 415-836-2522
Facsimile: 415-836-2501

Customer No. 29585

Page 17 of 17

Gray CaryASFJ098960.1
2502440-991501